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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/037,910	11/09/2001	Michael D. Cutbirth	CLW001	6896
25235	7590	10/18/2007		
HOGAN & HARTSON LLP ONE TABOR CENTER, SUITE 1500 1200 SEVENTEENTH ST DENVER, CO 80202			EXAMINER AKINTOLA, OLABODE	
			ART UNIT	PAPER NUMBER
			3691	
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			10/18/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/037,910

Applicant(s)

CUTBIRTH, MICHAEL D.

Examiner

Olabode Akintola

Art Unit

3691

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 19 and 22-25 is/are pending in the application.
- 4a) Of the above claim(s) 19, 24 and 25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22 and 23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 19 and 22-25 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

Newly amended claims 19, 24-25 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claims 19, 24-25 are drawn to debt component comprising single tranche debt structure having an amortization based in part upon tax credits while claims 22 –23 are drawn to dual tranche debt structure.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 19, 24-25 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Examiner notes that some claims were deemed allowable in the prior office action dated 5/3/2007, however, upon further review and search, the allowance of these claims is hereby withdrawn.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Karp et al (US 6832209) (hereinafter "Karp") in view of Lee (Wind energy developments: Incentives in selected countries, 1998) (hereinafter "Lee"), in view of Minyard et al ("Financing LNG Projects: The Challenges ahead", Journal of Project Finance, 1997, Vol. 3, Iss. 3) (hereinafter referred to as "Minyard") and further in view of Randolph et al ("The Use of the Capital Markets to fund Ras Gas Project", Journal of Project Finance, 1997, Vol. 3, Iss. 2) (hereinafter referred to as "Randolph")

Re claims 22-23: Karp teaches method for creating a tax-advantaged investment fund comprising: forming an entity having a business form that enables the entity to passthrough tax benefits (fig. 3, RN {440}, col. 7, lines 17-33); establishing the tax-advantaged investment fund having a plurality of investors comprising a plurality of equity members (fig. 3, col. 9, line 55 through col. 10, line 9); collecting capital from the plurality of investors (col. 6, lines 59-65). Karp does not explicitly teach the use of the capital to purchase a plurality of wind energy projects having a return comprising a cash flow distribution, accelerated depreciation deduction and tax credits; collecting a debt component from at least one lender; and providing said debt component directly to one of a plurality of wind energy projects, wherein said debt component

comprises a dual tranche debt structure including a first portion of debt having a first amortization period of a fixed number of years based on cash flow of the projects and a second portion having a second amortization period based in part upon the timing of the capital that is contributed from the plurality of investors. However Karp teaches using the capital to purchase a plurality of financial instruments having a return comprising a cash flow distribution (fig. 3).

Lee teaches investment in wind energy projects having returns comprising a cash flow distribution, accelerated depreciation deduction and tax credits (page 4 through page 7). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Karp to include wind energy investment as taught by Lee. One would have been motivated to do so in order to take advantage of the various incentives associated with wind energy projects by reducing investor tax obligations to the government and effectively lowering the investor's cost by the amount of the tax savings.

Minyard teaches collecting capital from investors and collecting debt component from lenders, providing said debt component directly to one of the plurality of projects, said debt component having an amortization period of a fixed number of years based on cash flow of the projects (page 2 of 7, paragraphs 8-9). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Karp to include these features as taught by Minyard. One would have been motivated to do so in order to supplement the capital contributed by the investors for the expansion of the projects.

Randolph teaches dual tranche debt structure having a first amortization period and second amortization period based on the timing of the capital that is contributed by investors (page 7 of 10, paragraph 9). It would have been obvious to one of ordinary skill in the art at the time of the

invention to modify Karp to include these features as taught by Randolph. One would have been motivated to do so in order to optimize debt amortization.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Federal Tax Issues Relating to Restructuring of the Electric Power Industry (Joint Committee on Taxation, October 15, 1999) teaches tax issues associated with wind energy projects financing.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olabode Akintola whose telephone number is 571-272-3629. The examiner can normally be reached on M-F 8:30AM -5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3691

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

OA



**HANI M. KAZIMI**  
**PRIMARY EXAMINER**